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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,846	07/22/2003	Stephen Heslip	4361.100	6532
36412	7590	06/28/2005	EXAMINER	
DUCKOR SPRADLING METZGER 401 WEST A STREET, SUITE 2400 SAN DIEGO, CA 92101-7915			CHENG, JOE H	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

58

Office Action Summary	Application No. 10/624,846	Applicant(s) HESLIP, STEPHEN	
	Examiner Joe H. Cheng	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, all the claimed method steps, *inter alia*, configuring chord indicia in an ordered sequence to designate groups of chords for given keys, arranging the chord indicia and musical key indicia in a matrix, arranging the matrix in overlapping column, designating each column with an individual one of the musical key indicia and arranging the columns with each group of chords, and the window indicia must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3713

3. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the antecedent basis for all the claimed method steps has not been clearly set forth. In addition, it is noted that the claimed teaching aid is the computer for displaying the teaching material for teaching how to play as guitar. However, the structural elements of the computer and the display are lacking in the specification. It is also noted that the claimed invention is operated, performed and controlled by the computer and the computer programs. However, neither computer program nor a bare bone of flowchart is provided to enable one of ordinary skill in the art to make and use the claimed invention. Without a clear description of the computer program or flowchart, one ordinary skill in the art can not practice the invention without undue experimentation. If the computer program is well known in the art, applicant must disclose a full disclosure exists in the patents or other publications, which must not be only fully identified, but must accompanied by a teaching of how to incorporate the computer program into the claimed invention. ***NO NEW MATTER*** should be entered. Further, the term "finger position indicia 48, 49, 50 and 52" on page 4, line 10 of the specification should be recited as -- finger position indicia 48, 49, 50 and 51--, so as to clarify the confusion.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3713

5. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation therein is unclear and confusing, because the references for all the claimed method steps of making a stringed musical instrument learning aid, the learning aid and the method are unclear. Specifically, the structural elements of the claimed method steps or the structural elements cannot perform the functions of making, or facilitating for the learning of a stringed musical instrument. In addition, the antecedent basis for "said other column and another adjacent column" (as per claims 2 and 11) has not been clearly set forth.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims do not expressly or implicitly require performance of any of the steps by a machine, such as a general-purpose computer. There are several tests that can be applied to determine whether claims are directed towards statutory subject matter. They include: (1) a process under 35 USC 101 requires a transformation of physical subject matter, tangible or intangible, to a different state or thing; (2) the "abstract idea" exception; and (3) the claim must recite a practical application, that is useful, concrete, and tangible result. Regarding claims 1-9, the claims are directed to a method of making or facilitating a stringed musical instrument learning aid and do not require a transformation any physical subject matter, tangible

Art Unit: 3713

or intangible, into a different state or thing. A human can perform these claimed steps manually. For example, the step of “configuring chord indicia in an ordered sequence to designate groups of chords for given musical keys” could be performed by presenting a written or oral instruction to the subject to separate the playing cards or flash cards with each one of them having the musical chord and the given key of the elementary music course; the steps of “arranging the chord indicia and musical key indicia in a matrix” and “arranging the matrix in overlapping column” could be performed by presenting another written or oral instruction to the subject to arrange the playing cards or flash cards in a matrix form; the step “designating each column with an individual one of the musical key indicia” could be performed by assigning an individual indicia into each column of the matrix; and the step “arranging the columns with each group of chords comprising a plurality of column such that each key indicia comprising a designated column and at least one adjacent other key column” could be performed by presenting further instruction concerning the chord and musical key in the music concept. As discussed above since the claims method is not limited by a machine, the claim covers any and possible way that the steps can be performed and is more likely to be claim to an abstract idea. Abstract idea are not rooted in the technological arts and do not have a practical application. While presenting educational material of learning the stringed musical instrument may be useful and concrete, the steps in claims 1-9 do not require a machine and thus are tangible. Claims 1-9, therefore, fails to recite a claim that has a practical application.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3713

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 8-12 and 17 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Forrest (U.S. Pat. No. 4,716,806). The broadly claimed structure can be interpreted as the musical indicating apparatus of Forrest. Figs. 1-4 of Forrest broadly discloses the method and the learning aid for facilitating the learning of a stringed musical instrument comprising the chord indicia (i.e. A, A^b, B, B^b, C...) and the musical key indicia (i.e. MAJOR, MINOR, 7th...) configured in a circular matrix having a series of radial columns and concentric annual rows, and the designated column flanked by the other key column and another adjacent key column, and the matrix having overlapping columns, each column having an individual key indicia.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 3713

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 5-7 and 13-16 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Forrest (U.S. Pat. No. 4,716,806) in view of Weiss et al (U.S. Pat. No. 5,270,475). It is noted that the teaching of Forrest does not specifically disclose the finger position indicia (as per claims 4 and 13), the current chord display indicia (as per claims 5 and 14), the hear-a-sample button indicia (as per claims 6 and 15) and the fret number indicia (as per claims 7 and 16) as required. However, Figs. 1-20 of Weiss et al broadly discloses that such features of the finger position indicia, the current chord display indicia and the fret number indicia (see Figs. 14-16) to help designate the frets to be played for a given chord, and the hear-a-sample button indicia (218, 222) are old and well known. Hence, it would have been obvious to one of ordinary skill in the art to modify the learning aid and method of Forrest with the feature of the finger position indicia, the current chord display indicia, the hear-a-sample button indicia and the fret number indicia as taught by Weiss et al as both Forrest and Weiss et al are directed to the learning aid and method, so as to provide teaching information of the stringed musical instrument.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bova et al (U.S. Pat. No. 2,649,008) - note Figs. 1-6;

Gibby (U.S. Pat. No. 3,592,099) - note Figs. 1-4;

Malis (U.S. Pat. No. 3,668,967) - note Figs. 1-9;

Art Unit: 3713

Sapinski (U.S. Pat. No. 3,854,370) - note Figs. 1-4;
Choong (U.S. Pat. No. 3,960,046) - note Figs. 1-7;
Leonard (U.S. Pat. No. 4,002,097) - note Figs. 1-3;
Garcia Lorenzen (U.S. Pat. No. 4,037,518) - note Figs. 1-37;
Andersson (U.S. Pat. No. 4,069,737) - note Figs. 1-3;
Whitlock (U.S. Pat. No. 4,175,468) - note Figs. 1-16;
Roof (U.S. Pat. No. 4,286,495) - note Figs. 1-7;
Barber, Jr. (U.S. Pat. No. 4,503,748) - note Figs. 1-8;
Gunn (U.S. Pat. No. 4,961,362) - note Figs. 1-6;
Hiraoka (U.S. Pat. No. 5,173,566) - note Figs. 1-6C;
Hamzi (U.S. Pat. No. 5,288,234) - note Figs. 1-3;
Corley (U.S. Pat. No. 5,320,020) - note Figs. 1-7;
Dillard (U.S. Pat. No. 5,370,539) - note Figs. 1A-9A;
Owen (U.S. Pat. No. 5,585,583) - note Figs. 1-16;
Kennedy (U.S. Pat. No. 5,690,496) - note Figs. 1-8;
LeGrange (U.S. Pat. No. 5,709,552) - note Figs. 1-4;
Papadopoulos (U.S. Pat. No. 6,031,172) - note Figs. 1-17;
Fukata (U.S. Pat. No. 6,188,008 B1) - note Figs. 1-13;
Eller (U.S. Pat. No. 6,201,174 B1) - note Figs. 1A-9F;
Landtroop (U.S. Pat. No. 6,265,651 B1) - note Figs. 1-10;
Bennett (U.S. Pat. No. 6,288,315 B1) - note Figs. 1-16D;
Tice et al (U.S. Pat. No. 6,751,439 B2) - note Figs. 1-30;

Art Unit: 3713

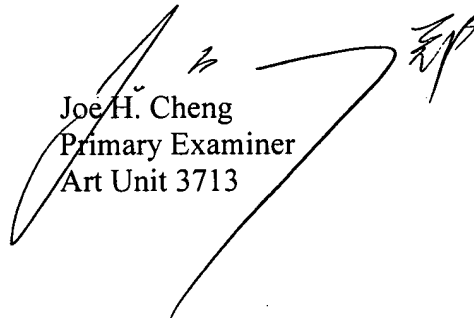
George (U.S. Pat. No. 6,841,724 B2) - note Figs. 1A-23.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe H. Cheng whose telephone number is (571)272-4433. The examiner can normally be reached on Tue - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joe H. Cheng
June 24, 2005



Joe H. Cheng
Primary Examiner
Art Unit 3713